

REMARKS

The Applicant respectfully requests entry of the above amendments, and consideration of the application, as amended.

By this amendment, the Applicant has amended claims 1, 23, 30, and 35 to more precisely recite aspects of the present invention. Claim 58 was cancelled and new claim 62 was introduced. No new matter has been introduced.

Claims 1-9, 11, 23-27, 29-39, 41, 42, 55-57, and 59-62 are now pending in this application.

1. Response to Anticipation Rejection based upon Tobias

In paragraphs 1 and 2 on pages 2-4 of the Action, the Patent Office rejected claims 1-4, 6-8, 11, 23-27, 29-38, 41, 42, and 55-57, 60 and 61 under 35 USC 102(b) as anticipated by U.S. Patent 5,115, 974 of Tobias, et al. [herein "Tobias"]. The Applicant respectfully submits that this rejection based upon Tobias is inappropriate based upon the above amendment. The Applicant requests that this rejection be reconsidered and withdrawn in view of this amendment.

Again, as discussed in the Response dated June 24, 2005 (the disclosure of which is incorporated by reference herein in its entirety), MPEP § 2131 provides guidelines under which an anticipation rejection is appropriate (these are not repeated here for brevity). The Applicant respectfully submits that Tobias does not include "each and every element" of the invention recited in the amended claims, nor does Tobias show the invention "in as complete detail" as the amended claims.

With respect to the anticipation rejection of independent claims 1, 23, 30, and 35, the Applicant does not acquiesce to the U.S. Patent Office's misconstruing the "coping" 16 of Tobias as a the claimed "seat" and the pool of Tobias as the claimed "foot well." However, the applicant submits the above amendment clearly distinguishes the invention from Tobias. Specifically, the inventions recited in claims 1, 23, 30, and 35

now recite that the bathing enclosure have “a water level” and that the seat is positioned “beneath the water level of the enclosure.” Support for this amendment appears throughout the as-filed specification, but is most clearly shown in Figure 2 where seat 48 is shown below water level 44. As clearly shown in Figure 1 of Tobias, the claimed “seat” 16 of Tobias is clearly above the water level of the water 22 of the pool of Tobias. The Applicant requests that these rejections be reconsidered and withdrawn.

With respect to the rejections of claims 2-4, 6-8, 11, 24-27, 29, 31-34, 36-38, 41, 42, 55-57, 60, and 61 as anticipated by Tobias, these rejections are inappropriate for the same reasons that the rejections of claims 1, 23, 30, and 35 from which they depend, are inappropriate. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

2. Response to Obviousness Rejection based upon Ruderian and Friend

In paragraph 6 on pages 5-6 of the Action, the Patent Office rejected claims 1-4, 6-9, 11, 23-27, 29, 30, 32-38, 41, 42, and 55-61 under 35 USC 103(a) as obvious in view of the combined teachings of U.S. Patent 3,374,492 of Ruderian [herein “Ruderian”] and U.S. Patent 3,641,996 of Friend [herein “Friend”]. Again, the Applicant respectfully submits that these rejections are inappropriate. The Applicant requests that this rejection be reconsidered and withdrawn.

Under the heading “Response to Arguments” on pages 6-8 of the Action, the Patent Office claims that motivation exists for combining the teachings of Ruderian and Friend. The Patent Office asserts that since the two references are in the same art, it would be obvious to combine their teachings. However, though the references may be in the same art, simply stating that one can combine their teachings does not mean that the present invention would inherently ensue.

Recall that the Patent Office relies on the teachings of Friend to provide “a valve 13,” that is, a valve like any other valve known in the art. However, there is absolutely

no teaching or suggestion in Friend or in Ruderian that a valve 13 be positioned in the system of Ruderian to provide the desired function, that is, "to divert at least some of the pressurized water away from the water inlets and to the foot well" as recited in the present claims. Only the present application discloses that there is a benefit or advantage for providing such a diversion of flow, that is, to avoid increasing flow to the other water inlets - which will discomfort the bather - by innocuously directing the water to the foot well, as expressly recited in new claim 62. No such teaching or suggestion is provided in either Friend or Ruderian. For example, diverting flow from inlet 27 in Ruderian will increase flow to inlets 30 and 29, but will inherently also undesirably increase flow to inlet 28. Such an undesirable operation is avoided by aspects of present invention. The Applicant respectfully submits that the Patent Office is clearly resorting to hindsight reconstruction and using the Applicant's own disclosure as a basis for this rejection.

It is well established in the law that it is impermissible to use the Applicant's own disclosure as a basis for formulating a rejection under 35 USC 103. The second paragraph of MPEP 2142 instructs us in this regard.

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. [Emphasis added.]

The Applicant submits that the Patent Office has clearly transgressed this restriction when using the Applicant's disclosure as a basis for establishing this obvious

rejection in view of Ruderian and Friend. Again, the Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Moreover, the Applicant submits that Ruderian actually teaches away from the claimed invention. Specifically, the inlets 27, 28, 29, and 30 identified by the Patent Office do not inject water on the torso of the bather but on the feet and legs of the bather. Therefore, unlike the present invention, a variation in flow to this part of the body is unlikely to discomfort the bather. Thus, there is no motivation in Ruderian to redirect flow away from inlets 27, 28, 29, and 30 by means of a diverter.

It is well established that MPEP 2104.02 provides the following guidelines when considering the obviousness of a claimed invention in view of the prior art:

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) [Emphasis added.]

Again, the Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Furthermore, as explained in the earlier response dated May 30, 2006 (the Remarks of which are included by reference herein), Ruderian's steps 24 and 25 are not seats, as claimed. Regardless of the Patent Office's assertions that steps 24 and 25 "are capable of being used as a 'seat' and a 'footwell,'" as clearly disclosed in Ruderian, they are not. Again, as clearly recited by Ruderian:

These steps are designed to facilitate entry and exit from the bathtub and to help in supporting a user's body in various positions in the tub. For example, the person may lie substantially prone in the tub with his feet engaging either the first or second of the steps 24 and 25, depending upon his height. [Emphasis added.] (3:25-31)

Again, the Applicant requests that this rejection be reconsidered and withdrawn.

For these reasons, the Applicant submits that the inventions recited in claims 1, 23, 30, and 35 are not obvious in view of Ruderian and Friend. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

With respect to the rejection of dependent claims 2-4, 6-9, 11, 24-27, 29, 31-34, 36-39, 41, 42, and 55-61 as obvious in view of Ruderian and Friend, these rejections are inappropriate for the same reasons that the rejections of claims 1, 23, 30, and 35 from which they depend, are inappropriate. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

3. Conclusion

The Applicant believes that the Amendment overcomes the rejections of the subject Office Action and places the application in condition for allowance. An early and favorable action on the merits of the application is requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, the Applicant's undersigned Agent invites the Examiner to telephone him at the number provided.

Respectfully submitted,



John Pietrangelo
Agent for Applicants
Registration No. 39,331

Dated: November 17, 2006.

HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579